

07/19/04

AF/3679
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Express Mail Label No. EO904 392 868 US Date Deposited: 7/16/2004



In the United States Patent and Trademark Office

In re the Application of:

Leland James Wiesehuegel)
Serial Number: 09/773,197) Group:3679
Docket Number: AUS920000945US1) Examiner: Eric K. Nicholson
Filed on: 01/31/2001)
For: "Dynamic Catalog for On-Line)
Offering and Bid System"

APPEAL BRIEF

(AMENDED/CORRECTED UNDER 37 CFR 1.192(d))

Real Party in Interest

The subject patent application is owned by International Business Machines Corporation of Armonk, NY.

Related Appeals and Interferences

None.

Status of Claims

On April 28, 2004, appellant appealed from the final rejections of claims 1 - 15. Claims 1, 6 and 11 are independent claims, for which all amendments have been entered, as have been the amendments to claims 12 - 15 which are dependent on Claim 11. Claims 2 - 5 and 7 - 10 are in their originally-filed states. The claims are reproduced in the Appendix to this Appeal Brief.

Status of Amendments

The Specification was amended to correct minor typographical errors, and claims 1, 6 and 11 - 15 were amended prior to the issuance of the Final Rejections. All other claims remain in their originally filed states.

Summary of the Invention

The present invention comprises a three phase process for dynamically generating information such as product catalog information for use in conjunction with online auctions, business-to-business offering systems and retail sales. The invention is used by a supplier or seller of goods or services to produce “offer information” for one or more potential buyers in an arrangement wherein a third party, referred to as a “trader”, is responsible for accessing a larger list of items available from the supplier, and for producing an “offer” for each of the trader’s clients (e.g. buyers) wherein each offer only contains information on which the buyer is contractually allowed to bid during a subsequent auction.

As such, the invention tailors “offers” to potential bidders or buyers in a one-to-one arrangement (e.g. one supplier to one bidder), via or at the request of a trader, thereby creating a one supplier-to multiple traders - to multiple bidders arrangement.

Issues

All pending claims, Claims 1 - 15, were finally rejected under 35 U.S.C. §103(a) as being unpatentable over a primary reference, U.S. Patent 6,606,603, to Joseph, *et al.*, (hereinafter “Joseph”) in view of one of two secondary references, U.S. Patent 5,303,379, to Khoyi *et al.* (hereinafter “Khoyi”), and alternatively U.S. Patent 5,117,354 to Long *et al.* (herinafter “Long”).

At issue is whether or not the primary reference, Joseph, actually teaches all of the elements, steps and limitations of our claims, especially our independent claims, as relied upon in the rationale for the rejections. Khoyi, and alternatively Long, has been employed only as evidence of what would have been an obvious modification of one aspect of our claimed invention (e.g. information linking), while all other aspects of our claimed invention are believed by the examiner to taught directly by the primary reference.

More specifically, we contend that:

- (1) the proposed combinations fail to teach our elements or steps with respect to the preparation of offers by traders from product information from one supplier, promoting the offers for bid by bidders to an auction, and presenting the promoted offers via an online auction system for the same reasons, wherein the relationship forms a one supplier - to multiple traders - to multiple bidders relationship;

- (2) the primary reference is non-enabling with respect as to how to adapt it for use in a offeror-trader-broker auction environment, whereas its only mention of use in conjunction with an auction is simply a one-line “bullet” towards the end of the disclosure (just before the claims), and neither secondary reference is auction related;
- (3) in evaluating our claims with respect to the cited art, the examiner has not appropriately employed our definitions of “promoting” and “trader” as described in our disclosure, but has interpreted the primary reference’s use of the term “promote” with improper hindsight; and
- (4) the primary reference, ‘603 to Joseph, is taken from non-analogous art as it is directed towards online catalog preparation for order placement in which a many supplier-to-one buyer arrangement is provided (e.g. many suppliers’ catalogs are used to prepare information on behalf of just one buyer) without an intermediary party (e.g. with a trader), which is somewhat of an inverse operation of our online offer preparation system:
 - (a) Joseph provides *the buyer* with the ability to link into multiple *supplier* catalogs on demand *by the buyer*, while our system allows *one supplier* to produce product offerings (e.g. buyer-driven vs. seller-driven) tailored to each buyer via a trader;
 - (b) Joseph provides an online purchasing system (e.g. the buyers place purchase orders), while our system provides a system to prepare offerings in an online auction system (e.g. the sellers prepare information to post into an auction to potentially receive bids for those items for sale).

Grouping of Claims

Claims 1 - 15 stand or fall together.

The Examiner's Rationale

The examiner has reasoned that the proposed Joseph-Khoyi combination, and alternatively the Joseph-Long combination, teaches all of our following steps or elements as set forth in our independent claims:

- (a) providing at least two repositories of information sets and data items indexed to product part numbers or market identifiers is taught by Joseph;
- (b) dynamically linking the information sets and data items to part numbers for available products is taught by Khoyi or alternatively by Long;
- (c) upon request by a trader, synchronizing contents of a Sales Preparation System with the two or more repositories such that all information sets and data items within all repositories represent full information sets of most recently created data items, including the contents of said Sales Preparation System is taught by Joseph;
- (d) promoting the synchronized Sales Preparation System contents to an online auction system responsive to authorization of said trader is taught by Joseph; and
- (e) presenting the promoted contents to one or more online bidders via said online auction system is taught by Joseph.

Arguments**I. With respect to our first element or step as set forth in our independent claims:**

“providing at least two repositories of information sets and data items indexed to product part numbers or market identifiers”

Joseph teaches of “at least one catalog” (col. 4, line 7) and an index to the catalog by a “market identifier”, according to the examiner’s rationale (page 2, line 11 of the Office Action).

We are unable, however, to find anywhere in the Joseph disclosure the term “market identifier”, including performing a text string search for “market” and “identifier” separately on

'the HTML version of the text of the Joseph patent available on the USPTO's web site.

Our first claim element or step, however, requires at least two repositories of information, neither of which must be a catalog, because we are producing a catalog from various sources of raw information from one supplier, not consolidating multiple catalogs from multiple vendors.

Further, our "index" is by product part number, which would not likely be the same from one supplier to another. For example, a 40 GB hard drive from IBM would not have the same part number as a 40 GB hard drive from another supplier. But, in our scenario, the two or more repositories of information are owned by the same supplier, and thus the indexing by part number is possible.

Joseph, however, does not define "market identifier" as this term does not occur in the disclosure, and thus it is not possible that Joseph discloses indexing by part number as we have claimed. Additionally, Joseph does not disclose indexing of two or more information repositories, but rather discloses indexing of one or more catalogs (presumably one catalog from each of several suppliers).

Therefore, the examiner has erred by:

- (a) creating a definition for "market identifier" where no such definition exists in the cited art;
- (b) considering said "market identifier" as equivalent to our "part number"; and
- (c) equating our indexing of two information repository with indexing of two or more online catalogs.

II. With respect to our second element or step as set forth in our independent claims:

"dynamically linking the information sets and data items to part numbers for available products",

the examiner has stated that Joseph does not disclose "dynamically linking the information sets to part numbers for products nor synchronizing the contents of the server with the repositories", as we have claimed, but proposed that Khoyi, and alternatively Long, evidences that this is well known in the art. The examiner has reasoned that Khoyi or Long provides "a similar type of

catalog application".

It is important to note that Khoyi applies to the art of data object management, and integration of those objects (similar in concept to object-oriented programming, presumably). So, Khoyi's objects are data items by definition, and are not products or services for sale. Thus, Khoyi's "object catalog" would be a catalog of data objects, not a catalog of products or services for sale. As a direct result of this difference in field of endeavor by Khoyi, and difference in the use of the term "catalog", Khoyi is silent as to use of a "part number" as an indexing key or criteria. This is only reasonable, as the Khoyi disclosure is not directed towards cataloging of objects which would have part numbers (e.g. products or services), but is directed towards handling data objects.

It is also important to note that Long patent is related to producing *orders* (not offers) for lists of items which are to be directly purchased (not offered via an auction system) from a manufacturer, and more specifically for a system which creates these orders in an email system (not in an online auction system). As Joseph is also unrelated to auctioning systems, the combination of Joseph and Long does not pertain to, nor does it teach, online auctioning functionality, as one would expect of a combination of two non-auction patents. Additionally, the Long disclosure is silent as to dynamically linking the product information by market identifier or product number, as it only discloses downloading a file "containing items and product IDs" (col. 4, line 37 - 38, emphasis added). In fact, a word search of the Long disclosure using the online HTML text available at the USPTO web site reveals that there are no occurrences of the words "index", "indexing", "indexed", "dynamic" or "dynamically".

Neither Long nor Khoyi teach the missing elements of our claims, as discussed in the foregoing paragraphs related to the Joseph disclosure. Therefore, the examiner has erred in the following ways with respect to interpretation of our second claim element, step or limitation:

- (a) improperly equating Khoyi's "data object catalog" to our information repositories or and to Joseph's online product catalogs, without support for this definition being provided in the Khoyi disclosure;

- (b) improperly proposing that our indexing of information repositories by part number is disclosed by Khoyi when Khoyi is silent as to use of part number as a indexing criteria, as is Joseph;
- (c) improperly equating Long's "periodic accessing of email" and downloading files which contain items and "product IDs" as our step of dynamically linking information from multiple repositories, when Long clearly is disclosing a system to automate sales bid preparations from a single supplier (e.g. from a single repository), not for preparing "offers" to be listed in an auction;
- (d) improperly equating Long's downloading of files *containing* product IDs as our step or element of *indexing* information by product number or market identifier.

III. With respect to our third element or step as set forth in our independent claims:

"upon request by a trader, synchronizing contents of a Sales Preparation System with the two or more repositories such that all information sets and data items within all repositories represent full information sets of most recently created data items, including the contents of said Sales Preparation System"

Joseph is silent as to the role of a "trader" in making a request to initiate the synchronization process. We have defined a "trader" as an intermediary party between a supplier or "offeror" and a bidder or buyer, thus creating a three-party relationship, as follows:

"In such a business-to-business ("B2B") offering and bidding process (20), a manufacturer or service provider (21) will notify one or more traders (24) of available products or services, quantities, and minimum acceptable bid values (22). The trader then provides offerings (23') to one or more brokers (25), to which

the brokers may respond with bids (23)."

Joseph, however, is not directed towards such a three-party arrangement (supplier-trader-buyer), and not towards auction arrangements where in bids from buyers are received in response to offers being made by suppliers (e.g. manufacturers or service providers). In our arrangement, one supplier may provide information to multiple bidders or buyers, via one or more traders, within an offer to sell auction arrangement (e.g. one supplier to many traders to many buyers arrangement).

Joseph, on the other hand, provides the reverse arrangement, allowing one buyer to produce a catalog of a needed item from multiple catalogs from multiple sellers, and then to place an order with one of those suppliers (e.g. a many supplier to one buyer without an intermediary trader arrangement).

Further, as previously discussed, Joseph does not synchronize data between multiple information repositories which are from one supplier, as we have described and claimed, but rather indexes into one or more catalogs, wherein it has been established that Joseph's online catalog is not equivalent in all forms to our online information repository.

Khoyi does not, as previously discussed, synchronize information repositories into catalogs of products or services for sale, either, and is completely silent as to the role of a trader in the process.

Long does not synchronize information repositories into catalogs of products or services for sale, wherein the repositories are indexed by product number or market identifier. Rather, Long discloses downloading recently received emails, which reasonably would be indexed by sender, subject or date received, although Long is silent as to how or if their emails are indexed by anything at all. Long's server then calculates pricing, and emails a price quote is then uploaded to another computer. These steps of downloading email, calculating pricing, and uploading price quotes are not the same as synchronizing multiple repositories of information about products or services for sale as we have defined and claimed. Further, Long is silent as to the role of a third party or "trader" in this process, especially with respect to a three-party auction as we have disclosed and claimed.

Therefore, the examiner has erred in the following manners with respect to our third independent claim element, step or limitation:

- (a) neither Joseph, Long nor Khoyi disclose any operations which are “responsive to a request by a trader”;
- (b) Long and Khoyi do not disclose “synchronizing” repositories as we have claimed.

IV. With respect to our fourth element or step as set forth in our independent claims:

“promoting the synchronized Sales Preparation System contents to an online auction system responsive to authorization of said trader”

Joseph is nearly completely silent as to interaction with an auction system. In fact, the only occurrence of the word “auction” in the entire Joseph disclosure is found at column 9, line 20:

In other embodiments, several additional services for buyers and suppliers using the system 150 may be provided, including:

Auctions for surplus materials;

At first glance, this hardly seems to meet a test of enablement of how to use the Joseph ordering system as an online auction system, and especially how to use it in a supplier-trader-broker arrangement as we have described and claimed. Additionally, the entire Joseph disclosure is silent as to the use of the term “promote” or “promoting”.

But upon closer review, this single passage is describing “additional services” in an “other embodiment”, which “may” be provided. Certainly this opens the question as to whether the present invention is part of a surplus auction, or simply may be useful in association with an auction of some type.

Therefore, we believe it is an error by the examiner to rely upon this non-enabling passage in the Joseph disclosure for rejection of this element, step or limitation of our independent claims.

V. With respect to our fifth element or step as set forth in our independent claims:

“presenting the promoted contents to one or more online bidders via said online auction system”,

please refer to the foregoing arguments with respect to the fourth element, step or limitation of our claims, especially wherein Long and Joseph are unrelated to the arts of online auctioning.

VI. With respect to the rejections of our dependent claims, the errors described in the foregoing remarks apply as well to all rejected dependent claims.

Additionally, however, with respect to claims 2, 7, and 12, which stipulate that our synchronization of information repositories by part number is performed periodically, Joseph in view of Khoyi or Joseph in view of Long do not disclose synchronization by part number on any temporal basis.

With respect to claims 3, 8 and 13, which stipulate that our synchronization of information repositories by part number is performed in response to a request for information from any of the information repositories, Joseph in view of Khoyi or Joseph in view of Long do not disclose synchronization of information repositories indexed by part number on any triggering basis.

With respect to claims 4, 9 and 14, which stipulate producing a list having part numbers and links to information regarding the products associated with those part numbers, Joseph in view of Khoyi or Joseph in view of Long do not disclose use of part numbers at all, and thus do not disclose production of any lists using part numbers.

With respect to claims 5, 10 and 15, which stipulate saving a copy of dynamically linked information, inherently indexed by part number, to a static structure, Joseph in view of Khoyi or Joseph in view of Long are silent as to indexing any data or data structures by part number.

Summary

For the foregoing reasons, it is submitted that the examiner's rejections of Claims 1 - 15 were erroneous. Reversal of these decisions and allowance of the claims as they stand is respectfully requested.

Respectfully Submitted,

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Appendix**Clean Form of Amended Claims****Claim 1 (previously amended):**

A method for providing electronic catalogs of information sets regarding available products for bid or purchase through an online auction or bidding system collectively referred to as an Interactive Offer System, said method comprising the steps of:

 providing at least two repositories of information sets and data items indexed to product part numbers or market identifiers;

 dynamically linking said information sets and data items to part numbers for available products;

 upon request by a trader, synchronizing contents of a Sales Preparation System with said two or more repositories such that all information sets and data items within all repositories represent full information sets of most recently created data items, including the contents of said Sales Preparation System;

 promoting said synchronized Sales Preparation System contents to an online auction system responsive to authorization of said trader; and

 presenting said promoted contents to one or more online bidders via said online auction system.

Claim 2 (original):

The method as set forth in Claim 1 wherein said step of synchronizing is performed on a periodic basis.

Claim 3 (original):

The method as set forth in Claim 1 wherein said step of synchronizing is performed responsive to a request for said information sets in any of the repositories.

Claim 4 (original):

The method as set forth in Claim 1 further comprising the step of providing a list to a user, said list having part numbers and dynamic links to said information sets and data items associated with said listed part numbers.

Claim 5 (original):

The method as set forth in Claim 1 further comprising the step of saving a copy of an information set linked to a part number such that said saved copy is statically linked to said most recently created data items.

Claim 6 (previously amended):

A computer readable medium containing program code for providing electronic catalogs of information sets regarding available products for bid or purchase in through an online auction or bidding system collectively referred to as an Interactive Offer System, said program code when executed by a computer causing the computer to perform the steps of:

 providing at least two repositories of information sets and data items indexed to product part numbers or market identifiers;

 dynamically linking said information sets and data items to part numbers for available products;

 upon request by a trader, synchronizing contents of a Sales Preparation System with said two or more repositories such that all information sets and data items within all repositories represent full information sets of most recently created data items, including the contents of said Sales Preparation System;

 promoting said synchronized Sales Preparation System contents to an online auction system responsive to authorization of said trader; and

 presenting said promoted contents to one or more online bidders via said online auction system.

Claim 7 (original):

The computer readable medium as set forth in Claim 6 wherein said program code for synchronizing is adapted to perform synchronization on a periodic basis.

Claim 8 (original):

The computer readable medium as set forth in Claim 6 wherein said program code for synchronizing is adapted to perform synchronization responsive to a request for said information sets in any of the repositories.

Claim 9 (original):

The computer readable medium as set forth in Claim 6 further comprising program code for performing the step of providing a list to a user, said list having part numbers and dynamic links to said information sets and data items associated with said listed part numbers.

Claim 10 (original):

The computer readable medium as set forth in Claim 6 wherein said program code for further comprises program code for saving a copy of an information set linked to a part number such that said saved copy is statically linked to said most recently created data items.

Claim 11 (previously amended):

A system for providing a dynamic online listing of information regarding items available for purchase or bid through an online auction system, comprising:

- at least two computer-readable repositories of descriptive data items;
- a plurality of dynamic links between descriptive data items and product part numbers or market identifiers;
- a repository synchronizer which, responsive to a trader request, dynamically updates links to descriptive data items adapted to replace links to older data items with links to newer data items, and adapted to add links to data items which were not previously available;
- an offer promoter for promoting said synchronized Sales Preparation System contents to an online auction system responsive to authorization of said trader; and
- a user interface to an Interactive Offer System user interface adapted to present said promoted contents to one or more online bidders via said online auction system.

Claim 12 (previously amended):

The system as set forth in Claim 11 wherein said repository synchronizer is further adapted to replace and add links on a timed basis.

Claim 13 (previously amended):

The system as set forth in Claim 11 wherein said repository synchronizer is further adapted to replace and add links responsive to a request for information from said repositories.

Claim 14 (previously amended):

The system as set forth in Claim 11 further comprising a offer description creator adapted to capture or copy dynamically linked data items to a part number into a second set of descriptive data items which are statically related to said part number.

Claim 15 (previously amended):

The system as set forth in Claim 11 further comprising an offer list creator adapted to create a list of part numbers associated with dynamic links to said data items.

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